

REMARKS

Claims 1-15 are canceled. New claims 16-19 are added. Applicant thanks the Examiner for pointing out the ramifications of formatting the claims as a product by process. The new claims contain substantially the same process steps as previously claimed but presented as process claims *per se*. Applicant believes this will cure the lack of patentable weight previously ascribed to the process steps due to the prior product by process format.

35 USC 112, second paragraph

Prior claim 15 used the terms “sachet” and “brewing capsule” interchangeably. This was an oversight on applicant’s part. As the Specification explains, a sachet is one embodiment of a brewing capsule. Page 5, lines 11-12. Prior claim 15 thus made it unclear whether applicant intended to limit the claim to this embodiment. Claim 16 uses “brewing capsule” exclusively. Applicant submits this moots the ambiguity found in prior claim 15. Additionally, the process steps of the prior claim 15 were arguably unclear as to when the particulate coffee was formed, prior to or after enclosure within the brewing capsule. New claim 16 is clear that the compressed body is placed in the brewing capsule and then crushed to form the particulate coffee. Because new claim 16 clarifies the metes and bounds of the claimed process, Applicant respectfully requests the rejection be withdrawn.

35 USC § 103

Claims 1-15 were rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al. in view of Perry et al. (Perry’s Chemical Engineers’ Handbook 7th Edition pages 20-82 through 20-84). This rejection is technically moot in view of the claims’ cancellation. However, Applicant believes the Examiner’s diligent and thorough analysis of the process steps in these canceled claims are directly transferable to the instant claim. Consequently, Applicant respectfully traverses this prior rejection to the extent it is still pertinent to the instant process claims..

The current claims are not directed to the apparatus used nor the end product *per se* but rather a process. Applicant does not contest that roller presses and their uses were known in the art, nor does Applicant contest that packaged, ground coffee products were known in the art. The claimed process relates rather to the way in which a specific type of packaged

coffee product is produced. Because the prior claims were in product by process format, the Examiner focused on the implements used and end products primarily to assess whether the end product necessarily contained ascertainable structural features that distinguished over Murphy. Applicant respectfully requests the Examiner reconsider in view of the instant process claim format now used.

In particular, as the Examiner noted, “Murphy is silent to ...the coffee as in a brewing capsule ..., to the compressed coffee as placed in a sachet, sealing the sachets edges, and then crushing the coffee in the sachet....” Office Action, 17 Sept. 2009, pg. 4, first full paragraph. The secondary reference, Perry, is not cited as disclosing or suggesting the claimed process. *Id.* at 2nd full paragraph. The Examiner primarily concluded that the analogous product by process steps did not provide a patentable distinction to ultimate product. *Id.* pg. 6. This basis of the rejection is no longer applicable to the instant process claims. However, the Examiner further provided comments regarding the process steps themselves.

The Examiner cites to MPEP 2144.04 for the proposition that changing the order of a series of process steps is deemed *prima facie* obvious under governing legal precedent. *Id.* Applicant submits the Examiner is mistaken. MPEP 2144.04 (C) is entitled “Changes in Sequence of Adding Ingredients.” The difference between Murphy and the claimed process, for which the Examiner is attempting to account, is not a difference in the order of adding ingredients. Consequently, the Examiner mistakenly invokes this legal precedent to account for the claimed process. The Examiner’s mistake is understandable based on the MPEP’s characterization of *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) “(selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results)”. *In re Burhans* decision rested on the conclusion that the cited art expressly suggested the claimed process:

The cited references considered collectively clearly suggest doing the thing that appellant has done in this case and the Primary Examiner and the Board of Appeals correctly decided that the methods and article defined in the appealed claims were not patentable over the art of record for the reason that what appellant has done would be obvious to anyone skilled in the art.

FN1 - Appellant contends that the references taken singly or together do not teach his characteristic four steps which are new in the art and which are necessary to obtain the desired result. There is no merit in the point here in

the absence of any proof in the record that the order of performing the steps produces any new and unexpected results.

Id. at 1001 (emphasis added). In contesting obviousness, the Appellant had argued that the specifically claimed series of steps were “necessary to obtain the desired result.” The CCPA viewed this as an argument that the specifically claimed process steps, in the specific order claimed, yielded “new and unexpected results.” In a footnote, the CCPA discounted this argument as clearly deficient without evidentiary support for unexpected results. *Cf.* MPEP 2145. *In re Burhans* is thus stands for the general rule that rebuttal of a *prima facie* case of obviousness based on unexpected results requires proof of those unexpected results. *In re Burhans* does not set a precedent that rearrangement of process steps is deemed *prima facie* obvious by operation of law. In this regard compare MPEP 2144.04 (VI. C. Rearrangement of Part), “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.”. Because the differences between Murphy and the claimed process are not merely changes in the order of addition of ingredients, Applicant respectfully requests the Examiner reconsider the foregoing and withdraw this ground of rejection.

In an ancillary argument, the Examiner proposed a “motivation or reason for the worker in the art ... to make the necessary changes” to Murphy. Office Action, 17 Sept. 2009, pg. 5-6, bridging paragraph: “To enclose a compressed body to be crushed in a sachet would be common sense and routine determination of one of ordinary skill in the art.” Applicant respectfully requests the Examiner reconsider this analysis in view of the instantly presented process claims. Applicant requests the Examiner keep the following points in mind. Murphy performs a step of “regrinding the dense mass of roasted coffee to produce said roasted and ground coffee product...” Col. 4, lines 18-19; Col. 7, lines 51-54. Applicant respectfully submits that modifying Murphy to perform a step of feeding into a regrinding apparatus a sealed brewing capsule containing a compressed coffee body would, among other things, yield a product unsuitable for its intended purpose. MPEP 2145 (X. D.); 2143.01 (V.). The Examiner of course did not propose this. Rather the Examiner found it obvious to package the formed coffee “to be crushed.” Modifying Murphy to package and

crush a compressed coffee body, rather than regrind the compressed coffee pellets, would impermissibly modify the principle of operation of the Murphy process. MPEP 2143.01 (VI.). It appears that the Examiner inadvertently imported the Applicant's disclosure of a crushing step into the Examiner's obviousness analysis. MPEP 2145 (X. A.). With the foregoing in mind, Applicant respectfully requests the Examiner reconsider afresh the instant process claims.

If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully submits that because of their dependency from independent claim 16, claims 17-19 are nonobvious over the cited references for the same reasons as stated above for claim 16. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection to the extent it remains applicable to the process claims presented herein.

CONCLUSION

In view of the above, applicant believes the pending application is in condition for allowance. One month's extension of time is requested and the fee therefore co-submitted. Applicant believes no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03144US0 from which the undersigned is authorized to draw.

Dated: 01/18/2010

Respectfully submitted,

Electronic signature: /ALLEN E. WHITE/
Allen E. White
Registration No.: 55727
FULBRIGHT & JAWORSKI L.L.P.
Fulbright Tower
1301 McKinney, Suite 5100
Houston, Texas 77010-3095
(713) 651-5151
(713) 651-5246 (Fax)
Attorney for Applicant